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MOTOROLA INC
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EXAMINER

WENDELL, ANDREW

ART UNIT	PAPER NUMBER
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2618

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/804,292	Applicant(s) PECEN ET AL.	
	Examiner Andrew Wendell	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-18, 20-27 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2-10, 12-18, 20-27, and 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-4, 7-8, 18, 20, and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaheen et al. (US Pat Appl# 2004/0203792).

Regarding claim 1, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system teaches a method in a communication device for handover from a first radio access network UMTS (Fig. 7) to a second radio access network WLAN (Fig. 7), the first radio access network using a different mode of communication from the second radio access network (Section 0018), the method comprising entering an ongoing communication on the first radio access network UMTS (Fig. 7); detecting a presence of a second radio access network S6 (Fig. 7), the second radio access network being unregistered with the first radio access network at initial detection of the presence of the second radio access network while in the ongoing communication (Fig. 7 and Sections 0039-0043); and transferring the ongoing communication from the first radio access network to the second radio access network S16-S21 (Fig. 7 and Sections 0006-0009 and 0039-0043), wherein the

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first radio access network is a cellular radio access network (UMTS) and wherein the second radio access network is a wireless local area network (Fig. 7 and Sections 0006-0009 and 0039-0043).

Regarding claim 3, Shaheen teaches wherein the second radio access network is unregistered with the first radio access network by the first radio access network not initially having information on the second radio access network (Fig. 7 and Sections 0006-0009 and 0039-0043).

Regarding claim 4, Shaheen teaches transmitting a measurement report including a fictitious neighbor value S7 and S8 (Fig. 7).

Regarding claim 7, Shaheen teaches setting up a data session with the second radio access network; and querying the second radio access network for information relevant to a circuit handover (Fig. 7).

Regarding claim 8, Shaheen teaches transmitting a message via a messaging service, the message including information on the second radio access network, the message indicating a desire to transfer the call from the first radio access network to the second radio access network (Fig. 7).

Regarding claim 18, Shaheen teaches a communication device for handover from a first radio access network UMTS (Fig. 7) to a second radio access network WLAN (Fig. 7), the first radio access network using a different mode of communication from the second radio access network (Section 0018), the communication device comprising a transceiver (Fig. 7); a controller coupled to the transceiver, the controller configured to enter an ongoing communication on the first radio access network via the

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transceiver (Fig. 7); a network detection module configured to detect the presence of a second radio access network S6 (Fig. 7), the second radio access network being unregistered with the first radio access network at initial detection of the presence of the second radio access network while in the ongoing communication (Sections 0039-0043); and a handover module configured to transfer the ongoing communication from the first radio access network to the second radio access network S16-S21 (Fig. 7 and Sections 0006-0009 and 0039-0043), wherein the first radio access network is a cellular radio access network UMTS (Fig. 7) and wherein the second radio access network is a wireless local area network WLAN (Fig. 7).

Regarding claim 20, Shaheen teaches wherein the second radio access network is unregistered with the first radio access network by the first radio access network not initially having information on the second radio access network when the network detection module detects the presence of the second radio access network (Fig. 7 and Sections 0006-0009 and 0039-0043).

Regarding claim 24, Shaheen teaches wherein the controller is further configured to set up a data session with the second radio access network and query the second radio access network for information relevant to a circuit handover S9-S21 (Fig. 7).

Regarding claim 25, Shaheen teaches wherein the controller is further configured to transmit a message via a messaging service, the message including information on the second radio access network, the message indicating a desire to transfer the call from the first radio access network to the second radio access network (Fig. 7).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-6 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Boyer et al. (US Pat# 7,050,812).

Regarding claim 5, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system teaches the limitations to claim 1. Shaheen fails to teach a color code.

Boyer's method in channel assignment in a cellular network teaches wherein the fictitious neighbor value includes one selected from the group of a same radio frequency value as a broadcast channel carrier of the serving cell including with a different color code from the broadcast channel carrier of the serving cell, and a frequency value not used as a broadcast channel of the first radio access network of the serving cell (Col. 26 line 24-Col. 28 line 41).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a color code as taught by Boyer into Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to achieve a high degree of quality signals by minimizing the interference (Col. 2 lines 8-12).

Regarding claim 6, the combination including Boyer teaches wherein the color code comprises an information field including a first three bits of a base station identity code (Col. 26 line 24-Col. 28 line 41).

Regarding claim 22, the combination including Boyer teaches a same radio frequency value as a broadcast channel carrier of the serving cell including with a different color code from the broadcast channel carrier of the serving cell, and a frequency value not used as a broadcast channel of the first radio access network of the serving cell (Col. 26 line 24-Col. 28 line 41).

Regarding claim 23, the combination including Boyer teaches wherein the color code comprises an information field including a first three bits of a base station identity code (Col. 26 line 24-Col. 28 line 41).

5. Claims 9 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Stumpert et al. (US Pat Appl# 2004/0157600).

Regarding claim 9, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system teaches the limitations to claim 1. Shaheen fails to teach a short messaging service.

Stumpert's method for determining whether to grant access of a user equipment to a radio access network teaches wherein the messaging service is a short messaging service and wherein the message is a short messaging service message (Sections 0007, 0050, and 0054).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a short messaging service as taught by Stumpert into Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to save money and be more efficient (Sections 0004-0005).

Regarding claim 26, the combination including Stumpert teaches wherein the messaging service is a short messaging service and wherein the message is a short messaging service message (Sections 0007, 0050, and 0054).

6. Claims 10, 16-17, 21, 27, and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Ovesjo et al. (US Pat Appl# 2002/0160785).

Regarding claim 10, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system teaches a method in a radio access network for handover from a first radio access network UMTS (Fig. 7) to a second radio access network WLAN (Fig. 7), the first radio access network using a different mode of communication from the second radio access network (Section 0018), the method comprising recognizing an ongoing call of the communication device in a serving cell on the first radio access network (Fig. 7); receiving a measurement report S7 and S8 (Fig. 7) including an identifiable value associated with a serving cell of the first radio access network (Fig. 7); and transferring the call from the first radio access network to the second radio access network S16-S21 (Fig. 7 and Sections 0006-0009

and 0039-0043). Shaheen fails to teach a measurement report of the first radio access network.

Ovesjo's commanding handover between differing radio access technologies teaches a method in a radio access network for handover from a first radio access network to a second radio access network, the first radio access network using a different mode of communication from the second radio access network (Fig.1, Sections 0017-0020), the method comprising recognizing an ongoing call of the communication device in a serving cell on the first radio access network (Fig. 3); receiving a measurement report including an identifiable value associated with a serving cell of the first radio access network (Fig.3 and Sections 0032 and 0037-0038); and transferring the call from the first radio access network to the second radio access network (Fig. 3), wherein the identifiable value associated with the serving cell comprises a fictitious neighbor value (Fig.3 and Sections 0032 and 0037-0038).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a measurement report of the first radio access network as taught by Ovesjo into Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to have additional parameters in a handover command without lengthening the command message (Section 0016).

Regarding claim 16, the combination including Shaheen teaches wherein transferring the ongoing communication from the first radio access network to the second radio access network comprises switching the connection between the

communication device and the connected party via the first radio access network to a connection between the communication device and the connected party via the second radio access network (Fig. 7).

Regarding claim 17, the combination including Shaheen teaches wherein transferring the ongoing communication from the first radio access network to the second radio access network further comprises bypassing the first radio access network (Fig. 7).

Regarding claim 21, the combination including Ovesjo teaches wherein the controller is configured to enter a the ongoing communication by entering a call while operating in a serving cell of the first radio access network (Fig.1, Sections 0017-0020), and wherein the controller is further configured to generate and transmit a measurement report including a fictitious neighbor value associated with the serving cell (Fig. 3 and Sections 0032 and 0037-0038).

Regarding claim 27, Shaheen teaches a controller in a radio access network for handover from a first radio access network UMTS (Fig. 7) to a second radio access network WLAN (Fig. 7), the first radio access network using a different mode of communication from the second radio access network (Section 0018), the controller comprising a communication connection module configured to connect an ongoing communication of the communication device in a serving cell on the first radio access network S2 (Fig. 7); a measurement report module configured to receive a measurement report (Fig.3 and Sections 0032 and 0037-0038); and a handover module configured to transfer the ongoing communication from the first radio access network to

the second radio access network (Fig. 3 and). Shaheen fails to clearly teach a measurement report.

Ovesjo teaches a controller in a radio access network for handover from a first radio access network to a second radio access network, the first radio access network using a different mode of communication from the second radio access network (Fig.1; Sections 0017-0020), the controller comprising a communication connection module configured to connect an ongoing communication of the communication device in a serving cell on the first radio access network (Figs. 2 and 3); a measurement report module configured to receive a measurement report (Fig.3 and Sections 0032 and 0037-0038); and a handover module configured to transfer the ongoing communication from the first radio access network to the second radio access network (Fig. 3 and sections 0017-0020), wherein the measurement report comprises a fictitious neighbor value (Fig.3 and Sections 0032 and 0037-0038).

Regarding claim 33, the combination including Shaheen teaches wherein the ongoing communication is transferred from the first radio access network to the second radio access network comprises switching the connection between the communication device and the connected party via the first radio access network to a connection between the communication device and the connected party via the second radio access network (Fig. 7).

Regarding claim 34, the combination including Shaheen teaches wherein the ongoing communication is transferred from the first radio access network to the second radio access network further by bypassing the first radio access network (Fig. 7).

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7. Claims 12, 14, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Ovesjo et al. (US Pat Appl# 2002/0160785) and further in view of Boyer et al. (US Pat# 7,050,812).

Regarding claim 12, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in view of Ovesjo's commanding handover between differing radio access technologies teaches the limitations claim 10. Shaheen and Ovesjo fail to teach a color code.

Boyer's method in channel assignment in a cellular network teaches a same radio frequency value as a broadcast channel carrier of the serving cell including with a different color code from the broadcast channel carrier of the serving cell, and a frequency value not used as a broadcast channel of the first radio access network of the serving cell (Col. 26 line 24-Col. 28 line 41).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a color code as taught by Boyer into a measurement report of the first radio access network as taught by Ovesjo into Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to achieve a high degree of quality signals by minimizing the interference (Col. 2 lines 8-12).

Regarding claim 14, Boyer further teaches wherein the color code comprises an information field including a first three bits of a base station identity code (Col. 26 line 24-Col. 28 line 41).

Regarding claim 29, Boyer further teaches a same radio frequency value as a broadcast channel carrier of the serving cell including with a different color code from the broadcast channel carrier of the serving cell, and a frequency value not used as a broadcast channel of the first radio access network of the serving cell (Col. 26 line 24-Col. 28 line 41).

Regarding claim 30, Boyer further teaches wherein the color code comprises an information field including a first three bits of a base station identity code (Col. 26 line 24-Col. 28 line 41).

8. Claims 13, 15, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Ovesjo et al. (US Pat Appl# 2002/0160785) and further in view of Yahagi (US Pat# 7,065,360).

Regarding claim 13, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in view of Ovesjo's commanding handover between differing radio access technologies teaches the limitations in claim 10. The combination including Shaheen teaches wherein the second radio access network comprises a wireless local area network WLAN (Fig. 7) and the first radio access network comprises a cellular radio access network UMTS (Fig. 7). Ovesjo and Shaheen fail to teach the ongoing communication being a call.

Yahagi's multi-network communication system teaches wherein the ongoing communication comprises one of a data session and a call (Fig. 2 and Col. 4 lines 28-31).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate the ongoing communication being a call as taught by Yahagi into a measurement report of the first radio access network as taught by Ovesjo into Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to make communication easier and receive different services (Col. 1 lines 32-35).

Regarding claim 15, Yahagi further teaches wherein the ongoing communication comprises a connection between the communication device and a connected party (Fig. 2 and Col. 4 lines 28-31).

Regarding claim 31, Yahagi further teaches wherein the ongoing communication comprises one of a data session and a call (Fig. 2 and Col. 4 lines 28-31).

Regarding claim 32, Yahagi further teaches wherein the ongoing communication comprises a connection between the communication device and a connected party (Fig. 2 and Col. 4 lines 28-31).

Response to Arguments

Applicant's Remarks	Examiner's Response
"Applicants assert that Shaheen et al. does not disclose or suggest detecting a presence of a wireless local area network, the wireless local area network being unregistered with the cellular radio access network at initial detection of the presence	The wireless local area network is not registered with the radio access network in s1-s2 of Fig. 7. It listens for wireless local area network signals and then compiles a list of wireless local area networks available. It is similar to someone ease

of the wireless local area network while in the ongoing communication and transferring the ongoing communication from the cellular radio access network to the wireless local area network, as recited in independent claim 1 and similarly recited in independent claim 18.”	dropping in someone else’s conversation. The person having the conversation did not register the ease dropping person but the ease dropping person detects a conversation through listening and can come up with a list of the people having a conversation.
“Contrary to claims 10 and 17, the measurement report does not include a fictitious neighbor value. In particular, measurements, such as signal strength measurements of the first and second radio access networks are actual measurements. They are not fictitious measurements.”	The claim is broadly written and examiner believes applicant is reading more into the claim. Any measurement done can be fictitious. If the devices are not calibrated it can throw off measurements, multi-path fading can give fictitious measurements, interference, noise, and other situations can lead to fictitious measurements.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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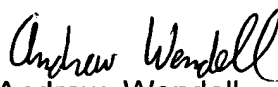
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Wendell whose telephone number is 571-272-0557. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 571-272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


NAY MAUNG
SUPERVISORY PATENT EXAMINER


Andrew Wendell
Examiner
Art Unit 2618

2/22/2007